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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/766,319	MADAN ET AL.
	Examiner	Art Unit	
	Alicia M. Lewis	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 December 2008</u>.

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>10,11,15,17,18,20-22 and 24-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>10,11,15,17,18,20-22 and 24-29</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail. Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This office action is responsive to communication filed December 30, 2008.

Claims 10, 11, 21, 22, and 24-28 are currently amended, and claim 29 has been added.

Therefore claims 10, 11, 15, 17, 18, 20-22 and 24-29 remain pending in this application.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 10, 20-22 are rejected under 35 U.S.C. 103(a) (*current application filing

date 1/26/2004*) as being unpatentable over Denoue et al. (US 2004/0119762 A1, *filing

date 12/24/2002*) ('Denoue') in view of Dawe et al. (US 7,042,594 B1, *filing date

3/7/2000*) ('Dawe'), and further in view of Beauchamp et al. (US 2008/0046837 A1, *filing

date 3/17/2003*) ('Beauchamp').

With respect to claim 10, Denoue teaches:

receiving a path drawn by a user via a stylus as input (paragraphs 54 and 86), the path defining boundaries of a selected region of a display (paragraph 59), wherein pixels comprising one or more graphical elements being displayed in the selected on-screen region (Figure 6, paragraph 67);

capturing the pixels displayed within the selected on-screen region (paragraphs 67 and 86-87), and storing the captured pixels such that the stored data is representative of only those pixels of the display within the selected on screen region (paragraph 89); and

obtaining context information for the one or more graphical elements by automatically applying text recognition (paragraph 79) to an annotation drawn by the user on the display via the stylus (*i.e. freeform inks 532, 534, 536 and freeform notes*) (paragraphs 57 and 75) (*OCR may be applied to captured content and captured content may include freeform inks, as seen in figs. 2-5*),

wherein context information is stored in association with the captured data (paragraphs 75-76).

Denoue does not explicitly teach storing captured data in an image file; storing the results of text recognition as context information; or automatically storing context information in association with the image file.

Dawe teaches a system and method for saving handwriting as an annotation in a scanned document (see abstract), in which he teaches:

capturing image pixels and storing captured image pixels in an image file (col. 3 lines 60-63, col. 7 line 61- col. 8 line 4);

applying text recognition to annotations and storing the results of text recognition as context information (col. 5 lines 52-60, col. 7 lines 6-20 and 61-65); and

automatically storing context information in association with the image file (col. 7 lines 57-65).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Denoue by the teaching of Dawe because storing captured data in an image file; storing the results of text recognition as context information; or automatically storing context information in association with the image file would enable handwriting to be saved as an annotation, and thus reduce clutter in a document presented to a user, while maintaining the information conveyed by the handwriting for presentation to the user if desired (Dawe, abstract).

Further regarding claim 10, Denoue in view of Dawe does not teach receiving a user command to annotate the one or more graphical elements and, in response to the user command, receiving an annotation drawn by the user on the display via the stylus.

Beauchamp teaches a transparent windows method and apparatus (see abstract), in which he teaches receiving a user command to annotate the one or more graphical elements (step 150 in Fig. 1B, paragraph 34), and receiving an annotation drawn by the user on the display via the stylus (step 156 in Fig. 1B, paragraphs 6 and

34). Beauchamp further teaches applying text recognition to the annotation drawn by

the user (paragraphs 6 and 28).

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have further modified Denoue by the teaching of

Beauchamp because receiving a user command to annotate the one or more graphical

elements and, in response to the user command, receiving an annotation drawn by the

user on the display via the stylus would enable annotation directly on the screen

display, much like the annotation of a physical sheet of paper with a marker, and would

further provide the ability to convert a user's handwritten notes into computer

recognized text and commands (Beauchamp, paragraph 6).

With respect to claim 20, Denoue as modified teaches wherein the context

information is stored in such a manner as to be accessible to a user for performing at

least one of the following:

searching for said image file;

displaying the context information simultaneously with the captured image pixels

(Denoue, paragraphs 75-76; Dawe, col.8 lines 1-16), and

navigating a network to a source of the captured image pixels.

With respect to claim 21, Denoue as modified teaches wherein the one or more

graphical elements comprises a first set of one or more textual characters, the method

further comprising: obtaining additional context information by extracting the first set of

one or more textual characters, extracting a second set of textual characters displayed

in proximity with the first set, and storing the first and second sets of textual characters

as the additional context information (Dawe, col. 7 lines 6-20 and lines 61-65; Denoue,

paragraph 72), the additional context information being automatically stored in

association with the image file (Dawe, col. 7 lines 57-65).

With respect to claim 22, Denoue as modified teaches wherein the selected on-

screen region is part of displayed textual region, and the graphical elements comprise a

first set of one or more textual characters displayed in the textual region, the method

further comprising: obtaining additional context information based on a second set of

one or more textual characters displayed in the textual region (Dawe, Fig. 4, col. 7 lines

6-20 and lines 61-65; Denoue, paragraph 72), the additional context information being

automatically stored in association with the image file (Dawe, col. 7 lines 57-65) (*The*

words "job" or "awareness" may be considered the second set of textual characters).

3.   Claim 11, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of

Dawe et al. (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe') and Beauchamp et al. (US

2008/0046837 A1, *filing date 3/17/2003*) ('Beauchamp'), as applied to claims 10 and 20-

22 above, and further in view of Oppermann et al. (US 6,334,157 B1, *filing date*

3/11/1997) ('Oppermann').

With respect to claim 11, Denoue as modified teaches claim 10, including a selected on-screen region and automatically storing context information in association with the image file (Dawe, col. 7 lines 57-65).

Denoue as modified does not teach determining a window associated with the selected on-screen region; retrieving an application interface having a uniform resource identifier (URI) property from the determined window or parent window of the determined window; or obtaining the URI property as additional context information.

Oppermann teaches programmatically providing direct access to user interface elements of an application program (see abstract), in which he teaches:

selecting user interface elements, such as text (col. 8 lines 43 and 49-51) and determining a window associated with the selected elements (col. 26 lines 37-40);

retrieving an application interface having a uniform resource identifier (URI) property from the determined window or parent window of the determined window (col. 25 lines 59-62, col. 28 lines 33-39); and

obtaining the URI property as additional context information (col. 11 lines 1-9, 55-60, col. 12 lines 55-60, col. 13 lines 51-60).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Oppermann because determining a window, retrieving an application interface having a uniform resource identifier (URI) property from the determined window or parent window of the determined window would enable accessibility aids the ability to access and manipulate

user interface elements of any application program without having prior knowledge of

the application program or its interface (Oppermann, column 4 lines 27-30).

        With respect to claim 25, Denoue as modified teaches wherein the selected on-

screen region includes at least a portion of a displayed web page or document (Dawe,

Figure 4, col. 4 lines 38-42), and the method further comprises: using an application

programming interface (API) to query an application for additional context information

(Oppermann, column 7 lines 36-38), the additional context information being

automatically stored in association with the image file (Dawe, col. 7 lines 57-65), the

queried application causing the one or more graphical elements to be displayed

(Oppermann, column 7 lines 36-45; Denoue, paragraphs 86-87).

        With respect to claim 26, Denoue as modified teaches further comprising

obtaining a uniform resource identifier (URI) of the web page or document as the

context information (Oppermann, col. 11 lines 1-9, 55-60, col. 12 lines 55-60, col. 13

lines 51-60), the URI being obtained as a result of the query using the API (Oppermann,

column 7 lines 36-38).

4.   Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of

Dawe et al. (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe') and Beauchamp et al. (US

2008/0046837 A1, *filing date 3/17/2003*) ('Beauchamp'), as applied to claims 10 and 20-

22 above, and further in view of Browne et al. (US 2004/0135815 A1, *filing date 12/15/2003*) ('Browne').

With respect to claim 15, Denoue as modified teaches claim 10.

Denoue as modified does not teach creating and storing a linking structure as the association between the image file and the context information.

Browne teaches a method and apparatus for image metadata entry (see abstract), in which he teaches creating and storing a linking structure as the association between the image file and the context information (Figure 12, paragraph 136).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Browne because teach creating and storing a linking structure as the association between the image file and the context information would enable an easy and efficient method of classifying and storing digital images (Browne, paragraph 14).

With respect to claim 18, Denoue as modified teaches wherein the linking structure includes at least one pointer pointing to the stored image file or the stored content information (Browne, paragraph 136).

5.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of Dawe et al (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), Beauchamp et al. (US 2008/0046837

A1, *filing date 3/17/2003*) ('Beauchamp'), and Browne et al. (US 2004/0135815 A1, *filing date 12/15/2003*) ('Browne'), as applied to claims 15 and 18 above, and further in view of Newman (US 2003/0101156 A1, *filing date 11/26/2001*).

With respect to claim 17, Denoue as modified teaches claim 15.

Denoue as modified does not teach wherein the linking structure is incorporated in a file separate from the stored image file and the stored content information.

Newman teaches database systems and methods (see abstract), in which he teaches wherein the linking structure is incorporated in a file separate from the stored image file and the stored content information (paragraph 16).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Newman because wherein the linking structure is incorporated in a file separate from the stored image file and the stored content information would enable additional information about image files, such as the origination device, person who created the file, and data/time the file was created, to be transmitted and stored along with the image files (Newman, paragraph 16).

6.   Claims 24, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue') in view of Dawe et al (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe'), as applied to claims 10 and

20-24 above, and further in view of Hertzfeld et al. (US 2002/0076109 A1, *filing date*

1/25/1999) ('Hertzfeld')

With respect to claim 27, Denoue teaches:

receiving a path drawn on the display by a user via a stylus (paragraphs 54 and

86), the drawn path defining the boundaries of a selected on-screen region of the

display, the selected on-screen region comprising a plurality of pixels (Figure 6,

paragraphs 59 and 67);

capturing the plurality of pixels of the on-screen region (paragraphs 67 and 86-

87); and

storing the captured image pixels such that the stored data is representative of

only those pixels of the display within the selected on screen region (paragraph 89),

wherein the content displayed within the on-screen region includes textual data or

underlying data comprising at least one of an executable object, a file, and a link to

remote content (paragraphs 39 and 55-57); and

extracting a character or word from textual data as context information

(paragraph 79); and

storing the extracted context information in association with the captured data

(paragraphs 75-76).

Denoue does not teach: storing captured data in an image file; automatically

determining whether the content displayed within the on-screen region includes textual

data; when the displayed content of the on-screen region is determined to include textual data, automatically extracting a character or word from the textual data as context information; or storing the extracted context information in association with the image file, such that the context information is accessible when viewing the image file.

Dawe teaches a system and method for saving handwriting as an annotation in a scanned document (see abstract), in which he teaches:

capturing image pixels and storing captured image pixels in an image file (col. 3 lines 60-63, col. 7 line 61- col. 8 line 4);

automatically determining whether the content displayed within the on-screen region includes textual data (col. 6 lines 52-53, col. 7 lines 11-14);

when the displayed content of the on-screen region is determined to include textual data, automatically extracting a character or word from the textual data as context information (col. 7 lines 6-8 and 15-20); and

storing the extracted context information in association with the image file, such that the context information is accessible when viewing the image file (col. 7 lines 57-60, col. 8 lines 1-16).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Denoue by the teaching of Dawe to enable handwriting to be saved as an annotation, and thus reduce clutter in a document presented to a user, while maintaining the information conveyed by the handwriting for presentation to the user if desired (Dawe, abstract).

Further regarding claim 27, Denoue in view of Dawe does not teach automatically determining whether the displayed content of the on-screen region includes underlying data comprising at least one of: an executable object, a file, and a link to remote content; or when the displayed content of the on-screen region is determined to include underlying data, automatically extracting a property of the underlying data as context information, the property comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, and meta-data.

Hertzfeld teaches a method and apparatus for context sensitive text recognition (see abstract), in which he teaches:

automatically determining whether the displayed content of the on-screen region includes underlying data comprising at least one of: an executable object, a file, and a link to remote content (step 608 in Figure 6, paragraph 38); and

when the displayed content of the on-screen region is determined to include underlying data, automatically extracting a property of the underlying data as context information, the property comprising at least one of: a file name, a file identifier, a

uniform resource locator (URL), a uniform resource identifier (URI), a folder name, and meta-data (step 616 in Figure 6, paragraph 38).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Denoue by the teaching of Hertzfeld because automatically determining whether the displayed content of the on-screen region includes underlying data comprising at least one of: an executable object, a file, and a link to remote content; or if the displayed content of the on-screen region is determined to include underlying data, automatically extracting a property of the underlying data as context information, the property comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, and meta-data would enable recognition of predefined types of text and predefined actions to be performed based on the types of text (Hertzfeld, abstract).

The limitations "automatically extracting a character or word from the textual data as context information" and "automatically extracting a property of the underlying data as context information, the property comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, and meta-data" are conditional statements, and thus optionally patentable. The limitations only occur if/when another action occurs, and thus do not limit the claim.

With respect to claim 24, Denoue as modified teaches:

digitizing movements of a stylus across the display in order to receive the annotation (Denoue, paragraphs 55, 57 and 75); and

obtaining additional context information based on the received annotation (Denoue, paragraph 79), the additional context information being automatically stored in association with the image file (Dawe, col. 7 lines 57-65).

With respect to claim 29, Denoue as modified teaches wherein the content of the selected on-screen region includes both textual data and underlying data comprising at least one of: an executable object, a file, and a link to remote content (Hertzfeld, steps 602 and 608 in Figure 6, paragraph 38), and both the extracted property of the underlying data and the extracted character or word are stored in association with the image file (Hertzfeld, paragraph 38; Dawe, col. 7 lines 57-65; Denoue, paragraph 75) (*Hertzfeld teaches that when the text represents a web address, the web address is extracted and the web page is displayed. Dawe teaching storing context in association with the image file; thus, when combined, Dawe would store the recognized web address as context. Furthermore, Denoue teaches storing metadata, including URLs in association with captured content*).

7.   Claims 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dawe et al (US 7,042,594 B1, *filing date 3/7/2000*) ('Dawe') in view of Beauchamp et al. (US 2008/0046837 A1, *filing date 3/17/2003*) ('Beauchamp'), and further in view of Denoue et al. (US 2004/0119762 A1, *filing date 12/24/2002*) ('Denoue').

With respect to claim 28, Dawe teaches:

receiving a path drawn on the display by a user via a stylus (col. 5 lines 28-30; col. 6 lines 48-50), the drawn path defining the boundaries of a selected on-screen region of the display, the selected on-screen region comprising a plurality of pixels (col. 6 lines 42-51);

capturing the plurality of pixels of the on-screen region (col. 3 lines 60-63, col. 7 lines 40-42 and lines 61-65, col. 8 lines 1-3);

storing the captured pixels as an image file (col. 3 lines 60-63, col. 7 lines 40-42 and lines 61-65, col. 8 lines 1-3), wherein the content displayed within the on-screen region includes textual data, an executable object, a file, and a link to remote content (col. 4 lines 46-59, col. 7 lines 38-40);

performing text recognition on an annotation to produce recognized text of the annotation as context information (col. 5 lines 36-43, col. 7 lines 6-20, col. 8 lines 19-29);

automatically determining that the content displayed within the on-screen region includes at least one of textual data and other underlying data comprising at least one of an executable object, a file, and a link to remote content (col. 6 lines 52-53, col. 7 lines 11-20);

automatically extracting as additional context information at least one of:

a character or word from the textual data as context information (col. 7 lines 6-20 and 57-65, col. 8 lines 19-26); and

a property of underlying data determined to be included in the on-screen region, the property comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, and meta-data; and

storing the context information and the additional context information in association with the image file, such that the context information is accessible when viewing the image file (col. 7 lines 57-60, col. 8 lines 1-16).

Dawe does not teach receiving a user command to annotate the content displayed within the on-screen region; in response to the user command, receiving an annotation drawn on the display by the user via the stylus; or performing text recognition of the annotation (drawn on the display) to produce recognized text of the annotation as context information.

Beauchamp teaches a transparent windows method and apparatus (see abstract), in which he teaches:

receiving a user command to annotate the content displayed within the on-screen region (step 150 in Fig. 1B, paragraph 34);

in response to the user command, receiving an annotation drawn on the display by the user via the stylus (step 156 in Fig. 1B, paragraphs 6 and 34); and

performing text recognition of the annotation (drawn on the display) to produce recognized text of the annotation as context information (paragraph 6).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dawe by the teaching of Beauchamp

because receiving an annotation drawn on the display by the user via the stylus; or

performing text recognition of the annotation (drawn on the display) to produce

recognized text of the annotation as context information would enable optimization of

pen-based annotations on a window of a software application (Beauchamp, paragraph

8).

Further regarding claim 28, Dawe in view of Beauchamp does not teach storing

captured pixels such that the image file is representative of only those pixels of the

display within the on-screen region.

Denoue teaches systems and methods for freeform pasting (see abstract), in

which he teaches capturing content, and storing captured content (pixels) such that the

image file is representative of only those pixels of the display within the on-screen

region (paragraph 89).

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have further modified Dawe by the teaching of Denoue

because storing captured content would enable the user or other users to ability to

reselect content in a simplified manner (Denoue, abstract, paragraph 89).

Response to Arguments

8.   Applicant's arguments with respect to claims 10, 11, 15, 17, 18, 20-22, 25, and

26 have been considered but are moot in view of the new ground(s) of rejection.

9.   Applicant's arguments filed December 30, 2008 have been fully considered but they are not persuasive.

10.   In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that none of the cited references teach storing captured pixels such that the image file is representative of only those pixels of the display with the selected region. Examiner disagrees. Denoue teaches capturing a selected on-screen region and storing only the captured pixels (paragraph 89); thus the stored pixels are only representative of those pixels of the display within the selected on-screen region. The examiner acknowledges that Denoue does not explicitly teach that the captured data is stored in an image file. Dawe, however, teaches capturing image pixels and storing captured image pixels in an image file (col. 3 lines 60-63, col. 7 line 61- col. 8 line 4). Thus, the combination of Denoue and Dawe teaches the above limitation.

11.   Regarding claims 10 and 28, Applicant argues that the cited references fail to teach receiving a user command to annotate content and in response to the user command, receiving an annotation. Examiner disagrees. Beauchamp teaches that at step 150 in Figure 1B, a user selects to enter pen annotations or non-pen annotations, i.e. by a mouse click, and in response to the user selecting to enter pen-annotations, user input is generated (step 156). Thus Beauchamp teaches receiving a user

command to annotation (i.e. a "yes" to decision step 150) and receiving an annotation

drawn by a stylus (user input in step 156).

12.   Applicant argues that Beauchamp does not teach receiving a user command or

receiving an annotation because he does not teach selecting and capturing pixels in an

on-screen region. Applicant is again arguing the references individually. Beauchamp

has not been used to teach the selecting and capturing steps. Beauchamp has been

combined with Denoue and Dawe to teach claims 10 and 28 are explained above. In

response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

13.   The Examiner would also like to point out that changing the "if" claim language to

"when" does not change the conditional status of limitations including such claim

language. The claim language "when" is also considered optional because it does not

require the step to actually occur.

Conclusion

14.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Lewis whose telephone number is 571-272-5599. The examiner can normally be reached on Monday - Friday, 9 - 6:30, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. M. L./
Examiner, Art Unit 2164
April 11, 2009

/Charles Rones/
Supervisory Patent Examiner, Art Unit 2164